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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/729,140

12/04/2003

Hiroshi Kanno

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EXAMINER

LEE, CHEUKFAN

ART UNIT

PAPER NUMBER

2625

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DELIVERY MODE

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/729,140	Applicant(s) KANNO, HIROSHI	
	Examiner Cheukfan Lee	Art Unit 2625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 June 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☒ Claim(s) 2-5 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>12/4/03 & 6/5/07</u> . | 6) <input checked="" type="checkbox"/> Other: <u>Copy of machine translated reference JP 2000-196839.</u> |

1. Claims 1- 5 are pending. Claim 1 is independent.
2. Claims 3/1 (meaning claim 3 depending on claim 1), 4/3/1, and 5/3/1 are objected to because of the following:

In claim 3/1, the language of line 8 and lines 9-10 creates confusion. On line 8, the term "said other data transmission means" lack antecedent basis, and on lines 9-10, the phrase "the limited range of transmission capacity set for said other data transmission means" lacks antecedent basis. The bases are set on lines 4-5 of claim 2 upon which claim 3 also depends, but claim 3/1 does not depend on claim 3/2. The same term and phrase also appear at the end of claim 3.

Claims 4/3/1 and 5/3/1 are objected to as being dependent on objected claim 3/1.

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Yamanaka (Japanese Patent Application Publication No. 2000-196839). Yamanaka was cited by Applicant in the IDS filed December 4, 2003 and discussed in the description of the

related art on pages 1 and 2 of the specification of the application. A machine translation of the JP reference is attached.

Claim 1 is written broadly such that it is met by Yamanaka.

Regarding claim 1, Yamanaka discloses an apparatus for transmitting reading data having a scanner function, a data transmission function and a data compression function (paragraphs 0010-0017, Figs. 2 and 3), the apparatus comprising a document reading means (scanner device 10) for reading a document having been subjected to data processing of a predetermined content (refer to "picture" of Yamanaka), a data compression means for compressing the data read from the document with a designated file format (see paragraph 0015, the last portion, step 4 of Fig. 3, and paragraph 0016, step 4 of Fig. 3), a data transmission means for transmitting the compressed data to a selectable destination (see paragraph 0017, step 10 of Fig. 3), and a transmission capacity limitation confirmation means (0016, step 5 of Fig. 3) for confirming a limitation on the transmission capacity set (by the final controlling element 12) for the data transmission means, the transmission capacity limitation confirmation means having a function of transmitting the read data to a designated destination via a designated data transmission means when it is confirmed that a data volume compressed for transmission falls within the limited range of transmission capacity set for the data transmission means (paragraph 0017, step 5; N and step 10 in Fig. 3).

5. Claim 2 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

6. Claims 3/2, 4/3/2, and 5/3/2 would be allowable if rewritten to overcome the objection(s) set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

7. The following is an examiner's statement of reasons for allowance:

Claim 2 would be allowable because Yamanaka (JP Publication No. 2000-196839) does not disclose that the transmission capacity limitation confirmation means comprises the claimed four functions claimed in claim 2.

Claims 3/2, 4/3/2, and 5/3/2 depend on claim 2.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Tanaka (U.S. Patent No. 5,832,126), "Method and apparatus for compressing mixed text and image data"

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cheukfan Lee whose telephone number is (571) 272-7407. The examiner can normally be reached on 9:30 a.m. to 6:00 p.m., Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward L. Coles can be reached on (571) 272-7402. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Cheukfan Lee/
Primary Examiner, Art Unit 2625